

REMARKS

The present document is submitted in reply to the Office Action dated June 23, 2009 ("Office Action").

Applicants have amended claims 1, 4, and 9 to more particularly point out the subject matter they deem as their invention. Support for this amendment can be found in original claim 15 and also in the specification, Figure 1C. Further, Applicants have amended the above-mentioned three claims, as well as claims 10-20, to promote clarity. Finally, Applicants have cancelled claims 5-8. No new matter has been introduced.

Upon entry of the present amendments, claims 1-4 and 9-20 will be pending. Among them, claims 1-4 have been withdrawn from consideration and claims 9-20 are under examination.

Applicants respectfully request that the Examiner reconsider this application in view of the following remarks.

Objections to the Specification

The Examiner objects to the "BRIEF DESCRIPTION OF THE FIGURES AND TABLES" in the specification, pointing out that it fails to indicate the sequence identifiers corresponding to the nucleotide sequences shown in certain figures. See the Office Action, page 4, item 8.

Applicants have amended this section to incorporate sequence identifiers, thereby rendering the objection moot.

Rejections under 35 U.S.C. § 102 and 103

The Examiner rejects claims 9-14 and 16-20 for anticipation or obviousness based on Sooter et al., Davis et al., Davis & Stozstak, and Short et al., either alone or in combination. See the Office Action, pages 9-18. On the other hand, she indicates that SEQ ID NO:1 is free of prior art. See the Office Action, page 18.

Applicants have amended independent claim 9 to recite SEQ ID NO:1. Thus, as acknowledged by the Examiner, claim 9 thus amended is neither anticipated nor rendered

obvious by the four cited references. So are claims 10-14 and 16-20, all of which depend from claim 9.

Rejection under 35 U.S.C. § 112, First Paragraph (Written Description)

Claims 9-14 and 16-20 are rejected for lack of written description. See the Office Action, pages 5-8, item 12.

Independent claim 9 will be discussed first. This claim, as amended, covers an aptamer selection system containing at least two components: (i) an antisense oligonucleotide having the nucleotide sequence of SEQ ID NO:1, and (ii) a library containing multiple oligonucleotides, each of which includes an antisense binding domain having a sequence complementary to SEQ ID NO:1 and at least one random nucleotide domain.

With respect to component (1), an antisense oligonucleotide, it is defined by a particular nucleotide sequence, i.e., SEQ ID NO:1. The present specification provides this particular sequence in Figure 1C. Thus, there is no doubt that Applicants were in possession of this antisense oligonucleotide at the time of filing this application.

Turning to component (2), the oligonucleotide library, Applicants would like to point out that, according to amended claim 9, each oligonucleotide in this library must include a domain including a sequence complementary to SEQ ID NO:1. Note that it is common knowledge to determine a sequence complementary to a defined nucleotide sequence, e.g., SEQ ID NO:1. Thus, by disclosing the nucleotide sequence of SEQ ID NO:1, the present specification also discloses adequately “a sequence complementary to SEQ ID NO:1,” the key characteristic of the library oligonucleotides contained in the claimed aptamer selection system. Given the disclosure of this key characteristic, a skilled person in the art would also acknowledge that Applicants were in possession of the oligonucleotide library recited in amended claim 9.

For the reasons set forth above, Applicants submit that a skilled artisan would have understood that Applicants were in possession of the aptamer selection system of amended claim 9. Pursuant to *Vas-Cath Inc. v. Mahurkar*, this claim satisfies the written description requirement. 935 F.2d 1555, 1563 (Fed. Cir. 1991) (“If a skilled artisan

would have understood the inventor to be in possession of the claimed invention at the time of filing, ... then the adequate description requirement is met.”).

Claims 10-14 and 16-20 are rejected on this ground merely due to their dependencies from claim 9. Thus, for the same reasons set forth above, these claims also meet the written description requirement.

Rejection under 35 U.S.C. § 112, Second Paragraph

The Examiner rejects claims 9-20 for indefiniteness. See the Office Action, pages 8-9, item 14. More specifically, she states that the phrase “a library oligonucleotide” recited in claim 9 is vague as it is unclear whether it refers to “one single library oligonucleotide” or “multiple oligonucleotides that constitute a library,” See the Office Action, page 9, first paragraph.

Applicants have amended claim 9 to make it clear that the aptamer selection system covered by this claim includes “an oligonucleotide library containing multiple oligonucleotides;” thereby obviating the Examiner’s ground for rejection.

As claims 10-20 are rejected on the same ground, the above-mentioned amendment to claim 9 has also overcome the rejection of these claims.

CONCLUSION

In view of the above remarks, Applicants submit that the present application is now in condition for allowance. A favorable consideration is therefore respectfully solicited.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any

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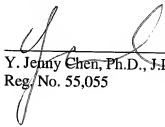
claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

The Petition for Extension of Time fee in the amount of \$ 555 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 50-4189, referencing Attorney Docket No. 77101-004US1.

Respectfully submitted,

Date: _____

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